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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,694	05/09/2001	Eric Thomas Best	88265-4032	3516

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EXAMINER	
HENDRICKS, KEITH D	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,694	BEST ET AL.	
	Examiner	Art Unit	
	Keith Hendricks	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *17,19 and 20* is/are allowed.

6)☒ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 remain rejected under 35 U.S.C. 102(b) as being anticipated by Smagula et al. (US PAT 5,011,704, of record).

Applicant's arguments filed December 12, 2003, have been fully considered but they are not persuasive.

At page 6 of the response, applicant states that "Smagula teaches a distinction between frozen and non-frozen states, and indicates that its products do not attain a predominantly glassy state at normal cold storage and distribution temperatures for ice confectioneries, as presently recited." Applicant also states that "Smagula teaches sauces having a flowable consistency over a wide temperature range" and thus "Smagula's sauces are flowable at freezer temperatures." This is not deemed persuasive for the reasons of record. As previously noted on the record, the specification states that "normal cold storage and distribution temperatures for ice confectionaries" is –30°C. Thus, in order for applicant to make comparison statements of the claimed product against the prior art, one must do look at the products within the same temperature range of "normal cold storage and distribution temperatures for ice confectionaries." Thus, as previously stated regarding the teachings of the reference, the confectionery mass is added to an ice cream mix having a temperature of between -25°C and -40°C, and "the center-filled deposits are then hardened further... and placed in frozen storage (col. 5, ln. 42 – col.6, ln. 44; underlining added). Further, regarding the passage at column 2, lines 14-18 of the reference, this refers to the state of the sauce at -12°C, where the instant claims recite a "chewy" consistency within a "transition temperature" of a broad range of "about -15°C to 0°C", thus not only encompassing the referenced product at -12°C, but also describing the same consistencies. In other words, neither the claimed product nor that of the reference, is in a "predominantly glassy state" within a temperature range of "about -15°C to 0°C". However, both are in a "predominantly glassy state" at "normal cold storage and distribution temperatures for ice confectionaries", i.e. at about –30°C.

It is also important to note that applicant's claimed invention is drawn to a product, regardless of where or when it exists. Any consideration of its properties at a future state, or within multiple different environments, is somewhat removed from the actual composition as it would exist at a 'normal' room ambient temperature. Any such recitation of a dissimilar state or future change in environment, still must result in a structural difference between the claimed invention and the prior art, in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of possessing the described properties at the different environments, i.e. tantamount to performing an intended use, then it meets the claimed invention.

It is further noted that applicant's reference to column 2, line 29 of Smagula et al. does not describe the actual properties of the product at sub-zero temperatures. This passage simply describes a normal, ambient temperature state of fudge sauces.

At pages 7-8 of the response, applicant states that "since the claimed chewy candy or analogues are prepared using at least different processes compared to Smagula, Smagula cannot be alleged to inherently teach the claimed ERH." This is not deemed persuasive, as this is simply not a fair comparison or accurate statement regarding the teachings of the reference. Even if an assumption is made that the processes to arrive at the materials are different, this does not inherently mean that the products will be different. Many known products of various industries are made by widely distinct processes, and yet provide the same resultant product. Further on point, applicant's statements made at the bottom of page 7 of the response, regarding an alleged comparison of the methods of production of the products, are not connected in any manner, and do not provide a direct comparison of the products or their mode of manufacture. Applicant's wording of these statements appears to overlap, yet also appears to be misleading. Thus, applicant's applied logic is flawed, and not well taken. Absent any clear and convincing evidence and/or arguments to the contrary, the referenced product would be expected to inherently possess an equilibrium relative humidity of at least about 70%, given the clearly-described product and process of manufacture in the reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Smagula et al., take as cited above, in view of the combination of Kuntz ("Food Product Design: Ice Cream Inclusions", 1994) and Lees et al. ("Sugar Confectionary and Chocolate Manufacture", of record).

Applicant's arguments filed December 12, 2003, have been fully considered but they are not persuasive.

The examiner's response to applicant's arguments regarding the teachings of Smagula et al. alone, are incorporated as stated in the rejection above. It is again noted that applicant's summation of the teachings of Smagula et al. is inaccurate, as neither the claimed product nor that of the reference, is in a "predominantly glassy state" within a temperature range of "about -15°C to 0°C". However, both are in a "predominantly glassy state" at "normal cold storage and distribution temperatures for ice confectionaries", i.e. at about –30°C.

Applicant's arguments presented at pages 7-8 of the response have been considered, but are not deemed persuasive for the reasons of record. At page 8 of the response, applicant states that the references do not suggest

> that a dual state material could be provided that is predominantly glassy and undergoes a chewy transition during consumption, as presently recited. The present invention is not simply reciting a material with a chewy texture at cold temperatures--it is surprisingly and unexpectedly reciting a material that is in a predominantly glassy state to facilitate rapid transformation into a chewy material in a chewy transition state.

This is not deemed persuasive for the reasons of record. Applicant's broad statements herein fail to accurately reflect the claimed invention. Applicant's claimed invention is necessarily related to the temperatures at which these properties are achieved. A general, broad statement that it is surprising and unexpected that a "predominantly glassy" material at a certain temperature, "undergoes a chewy transition during consumption," i.e. at a different warming temperature, is not deemed persuasive. Any person who has placed a caramel-containing candy bar in the freezer for a period of time, whether the caramel has completely hardened or not, has experienced this change in state, where upon consumption, the caramel is again warmed toward the ambient temperature and "undergoes a chewy transition during consumption." Thus, this effect is neither unexpected nor surprising. Therefore, one must examine and compare the properties of both the claimed product and the referenced product at the necessary temperatures. This has already been addressed as part of the 35 U.S.C. 102(b) rejection above. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As previously stated on the record, Smagula et al. provide a wide range of freezing-point temperatures and viscosities available, and Kuntz demonstrates that the adjustment of the texture of such inclusions is commonly performed, and well within the ordinary level of skill in the art. In fact, a "chewy type" of fudge sauce variegate was specifically suggested by Kuntz. Lees et al. simply demonstrates that one of ordinary skill in the art would readily know and have available the proper formulations for making such a product of chewy texture at freezing temperatures. Although the primary reference does not provide values for the ERH of the fudge sauce inclusions, this would have been well within the ordinary level of skill in the art to have determined, based upon the specific teachings of the primary reference, and, if necessary and desired, would have been obvious to have modified depending upon the desired texture. This again, was demonstrated and supported by the teachings of the secondary references, Kuntz and Lees et al.

Conclusion

Claims 17 and 19-20 are allowed, due to the recent amendment, and for the reasons of record in paper # 10.

Newly-added claim 21 is free of the prior art of record, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding this claim, it is noted that ice cream novelties and other frozen treats commonly comprise a coating material, often a caramel sauce. Smagula et al. described the frozen products being "dipped in a hardenable coating liquid" and processed for frozen storage (col. 5, ln. 64), where the preferred coating is stated to be "real chocolate, and may have crunchy puffed rice, chopped nuts or other inclusions" (top col. 6). However, there is no suggestion in the prior art of record, or in the state of the art at the time the invention was made, to utilize the claimed chewy candy or sugar confectionary as a coating for a food material item.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KEITH HENDRICKS
PRIMARY EXAMINER